

### REMARKS

Claims 1-30 currently remain in the application. Claims 8, 20 and 24 have been amended. Applicants respectfully request reconsideration in view of the preceding amendments and following remarks.

Applicants thank the Examiner for the courtesy extended during the telephonic interview with Applicants' representative on December 7, 2004. During this interview, low level light ranges as recited in the claims were discussed.

Claims 8, 20 and 24 have been amended to correct typographical errors in accordance with the Examiner's request. No new matter has been added.

Applicants gratefully acknowledge indication of allowability of claims 7, 8, 12-14 and 27, but believe all pending claims to be allowable.

### Rejections under 35 U.S.C. § 103

Claims 24-26 and 28-30 are rejected under 35 U.S.C. 103(a) as being obvious in view of US Patent No. 6,205,244 B1 to Bawolek et al. (referred to herein as 'Bawolek').

Claims 1-6, 9, 11, 15-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being obvious over Bawolek in view of US Patent Application No. US-2001/0156194 A1 to Sugiura et al. (referred to herein as 'Sugiura'). Applicants respectfully traverse the obviousness rejections.

The Office Action dated September 15, 2004 acknowledges that neither Bawolek or Sugiura teach the light range recited in independent claims 1, 20 and 24. The Office Action asserts that it would have been obvious to modify Bawolek and Sugiura to use the light ranges as recited in the independent claims. Applicants respectfully disagree: the proposed modification is not obvious.

The Office Action points to Applicants' Specification (page 7) to support obviousness. Applicants oppose this use of the Specification; the range provided by in the Specification refers to allowable light ranges suitable for use with the claimed invention, not the prior art. Calibration devices of the present invention are suitable for use with low light level imaging systems, which typically employ light levels below the threshold of human vision. These light ranges are not suitable for use with Bawolek and Sugiura, and the discussion on page 7 of the Applicants'

Specification (which describes the invention, not the prior art) is not an admission that these ranges are readily useable by the prior art to achieve the present invention.

Bawolek and Sugiura do not remotely suggest light ranges as claimed. Bawolek and Sugiura both calibrate at - or above - ambient light levels. Normal LEDs (Bawolek) each emit a radiance with about  $5 \times 10^{13}$  photons/second/centimeter squared/steradian, while the light bulbs 5 in Sugiura each emit about  $5 \times 10^{16}$  photons/second/centimeter squared/steradian. Light ranges of the prior art and the present invention are not readily interchangeable.

The light ranges as claimed would not work in the systems taught by Bawolek and Sugiura, and these systems cannot be extended to simultaneously remain functional and render the present invention unpatentable. More specifically, Sugiura's system includes an illumination light source 5 that illuminates a test chart 1 and a hole 2 in the test chart 1 (see paragraphs 78 and 82) such that a camera 6 can take a fully lit image of the test chart 1 and calibration light source 4 in hole 2. A calibration light source 4 of Sugiura with an emission as claimed would not be detectable in the system of Sugiura, especially with the light sources 5 on (about  $5 \times 10^{16}$  photons/second/ centimeter squared/steradian each). The light sources 5 would overpower the calibration light source 4 and render it undetectable, and thus the system of Sugiura would not work (if the camera cannot detect light source 4, there can be no calibration). Further, cameras sensitive enough to detect light ranges as claimed would saturate immediately with the light sources 5. "The proposed modification cannot render the prior art unsatisfactory for its intended purpose" (MPEP 2143.01). Bawolek has similar non-extendable differences in light range and thus cannot be used to practice light ranges as recited without becoming inoperable. Thus, both systems taught by Bawolek and Sugiura would become inoperable if they used the light ranges as recited, and cannot be used to render the present invention as obvious.

Therefore, Applicant respectfully submits that Bawolek and Sugiura, either alone or in combination, do not teach or suggest independent claims 1, 20 and 24, and that the independent claims are allowable.

Claims 2-6, 9, 11, 15-17, 19, 22-26 and 28-30 each depend either directly or indirectly from independent claims 1, 20 and 24 and are patentable over Bawolek and Sugiura for at least the reasons set forth above with respect to the independent claims.

Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Bawolek and Sugiura in further view of US Patent No. 6,642,953 B1 to Nieto Velasco et al. (referred to herein as 'Nieto Velasco').

Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Bawolek and Sugiura in further view of US Patent Application No. US-2001/0028510 to Ramm et al. (referred to herein as 'Ramm').

Claims 10, 18 and 21 each depend either directly or indirectly from independent claims 1 and 20 and are patentable over the art of record for at least the reasons set forth above with respect to the independent claims.

Based on the foregoing, all pending claims are allowable over the art of record.

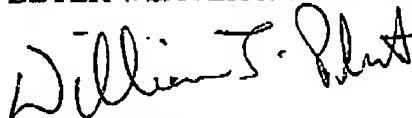
Withdrawal of the rejections of under 35 U.S.C. § 103(a) are therefore respectfully requested.

Applicants believe that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Response is to be charged to Deposit Account No. 50-0388 (Order No. XENOP007).

Respectfully submitted,

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Limited Recognition under 37 C.F.R. §10.9(b)

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**Expires: April 21, 2005**

  
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